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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/631,084	07/31/2003	John McCalla	131512-1012	2048
32914 7590 12/01/2008 GARDERE WYNNE SEWELL LLP INTELLECTUAL PROPERTY SECTION 3000 THANKSGIVING TOWER 1601 ELM ST DALLAS, TX 75201-4761				
EXAMINER				
SALCT, JASON P				
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2421				
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12/01/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/631,084

**Applicant(s)**

MCCALLA ET AL.

**Examiner**

Jason P. Salce

**Art Unit**

2421

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-75 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/02)
- Paper No(s)/Mail Date 3/18/04 and 5/14/04
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statements (IDS) submitted on 3/18/2004 and 5/14/2004 were filed after the filing date of the instant application on 7/13/2003. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Specification***

Claims 1-25 are objected to because of the following informalities:

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Antecedent basis must be established for the claim language, "computer-readable medium".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claims 1-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Referring to claims 1-25, the claims recite the limitation "computer-readable medium", where the specification of the instant application fails to specifically define the medium is tied to data stored on a computer medium or data transmitted over the broadcast signal. Therefore, the claim is interpreted as a signal/carrier wave storing the instructions that are received and executed by a receiving device. According to MPEP 2106.01 [R-6] signals/carrier waves have been deemed non-statutory subject matter.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 25-30, 50-55 and 75 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Galyean, III et al. (U.S. Patent No. 6,447,396).

Referring to claim 1, Galyean discloses receiving at least a portion of a video content for a game environment over a network (see Column 3, Lines 38-

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**40 for receiving and watching a broadcast television program and Figure 1 and Column 4, Lines 12-15 for receiving broadcast television programs from broadcast components 124 and 126).**

Galyean also discloses receiving at least a portion of a game application comprising of one or more interactive elements for said game playing (**see Column 7, Lines 58-62 for transmitting data to the clients that controls one or more interactive elements related to game playing**).

Galyean also discloses synchronizing the received video content with the received game application to present said one or more interactive elements in said game environment (**see Column 7, Lines 29-39 for synchronizing multiple clients through a central server and Column 4, Lines 20-37 for allowing viewers to interact in the viewer's own environment, another viewer's environment, or the television broadcast environment, thereby synchronizing the received video content with all of the viewer's game applications**).

Referring to claim 2, Galyean discloses storing said at least a portion of said game application in an interactive television device (**see Column 7, Lines 19-22 for storing a portion of a game application locally in a viewer's television device**).

Referring to claim 3, Galyean also discloses that one or more interactive elements comprises at least one action for execution in response to any input of

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a user made in connection with a frame of said received video content (**see Column 7, Lines 29-39 and Lines 51-57 for the game environment having state changes requested by viewer's to move characters from different regions to another (see Column 5, Lines 3-50) and transmitting the state changes to other client's through the server).**

Referring to claim 4, Galyean also discloses that at least a portion of said video content is received on-demand from a remote server in response to a request for said video by a user (**see Column 3, Lines 52-55 and Column 4, Lines 9-19 for receiving a television program upon demand (through the Internet or conventional cable network) by the viewer from server 120).**

Referring to claim 5, Galyean also discloses that at least a portion of said video content is received live from one or more broadcast channels in response to a request from said video content by a user (**see Column 3, Lines 52-55 and Column 4, Lines 9-11 for receiving a television program upon demand (through the Internet or conventional cable network) by the viewer).**

Referring to claim 25, Galyean also discloses that at least a portion of said game application is received over a data network (**see Column 7, Lines 12-62 and Figure 4 for transmitting game state information from clients through a server and Column 4, Lines 4-11 for the system using a data network to transfer information between the server and clients).**

Referring to claims 26-30 and 50, see the rejection of claims 1-5 and 25, respectively. Further note that Galyean discloses an apparatus (**element 106 in Figure 1**) for interactive game playing comprising a device comprising a processing and memory with instructions to perform the steps of claims 26-50 (**see Column 3, Lines 37-58 for the system being executed by a set-top box which contains a processor and memory**).

Referring to claims 51-55 and 75, see the rejection of claims 1-5 and 25, respectively.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-24, 31-49 and 56-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Galyean, III et al. (U.S. Patent No. 6,447,396) in view of Ohba (U.S. Patent No. 7,243,363).

Referring to claim 6, Galyean discloses all of the limitations of claim 1, but fails to teach determining whether a synchronizing trigger is associated with a current frame of the video content.

Ohba discloses game devices that synchronize video content displayed by two game machines based on synchronizing triggers (V-Sync signals) associated with a current frame of video content **(see Figure 12 and Column 10, Line 45 through Column 11, Line 48)**.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the game system, as taught by Galyean, using the synchronization signals including in the frames of the received video content, as taught by Ohba, for the purpose of enabling information processing by real-time communication by plural participants **(see Column 4, Lines 37-38 of Ohba)**.

Claim 7 corresponds to claim 6, where Ohba also discloses examining said at least a portion of said game application **(see Column 11, Lines 5-38 for two game playing machines A and B determining when commands are received, thereby teaching that a game application on game playing machine A and B examines when a game application is being manipulated)** to determine whether a synchronizing trigger is associated with a current frame **(further note Column 11, Lines 5-38 for each game machine receiving various data containing a synchronizing trigger (the frame number) that is associated with a frame processed by each opposing game machine)**.



Claim 8 corresponds to claim 6, where Ohba also discloses determining whether said current frame is a starting frame for said synchronizing trigger (**see Column 10, Lines 55-60 for receiving a starting frame including a V-Sync trigger**).

Claim 9 corresponds to claim 6, where Ohba also discloses activating an interactive element of said one or more interactive elements in response to said current frame being a starting frame for said synchronizing trigger (**see Column 11, Lines 45-48 for displaying picture signals from each game machine based on the synchronization process described in Figure 12**), wherein said activated interactive element is associated with said synchronizing trigger (**see Column 11, Lines 39-48 for displaying picture signals from each game machine based on the synchronization triggers and picture signals received by each game machine**).

Claim 10 corresponds to claim 9, where Galyean also discloses displaying a representation of said activated interactive element and said current frame on a display device (**see Column 4, Lines 1-3 for displaying a character (interactive element) along with the television show**).

Claim 11 corresponds to claim 6, where Ohba also discloses determining whether said current frame is a terminating frame for said synchronizing trigger

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**(see Column 10, Lines 30-35 for a subsequent V-Sync signal indicating the close of the picture signal generation).**

Claim 12 corresponds to claim 6, where Ohba also discloses deactivating an interactive element of one or more interactive elements in response to said current frame being a terminating frame for said synchronizing trigger **(see Column 10, Lines 30-35 for a subsequent V-Sync signal indicating the close of the picture signal generation, thereby deactivating the display of the interactive elements displayed during a game played by game machines A and B)**, wherein said deactivated interactive element is associated with said synchronizing trigger **(see again Column 10, Lines 30-35 where the picture signal is no longer displayed when a subsequent V-Sync (*synchronizing trigger*) is received).**

Claim 13 corresponds to claim 12, where Galyean also discloses displaying said current frame on a display device without a representation of said interactive element **(see Column 3, Lines 52-55 for the user selecting a television program and viewing the television program without displaying a character).**

Claim 14 corresponds to claim 7, where Galyean also discloses displaying said current frame on a display device **(see Column 6, Lines 19-45 for**

**displaying a current frame of a television program in addition to the user's characters, items and objects).**

Claim 15 corresponds to claim 14, where Galyean also discloses receiving a selection from a user **(see again Column 6, lines 19-45 for the user making a selection to move his/her character, items or objects).**

Claim 16 corresponds to claim 15, where Galyean also discloses determining whether said selection is associated with an interactive element of said one or more interactive elements **(see again Column 6, lines 19-45 for the user making a selection to move his/her character, items or objects).**

Claim 17 corresponds to claim 15, where Galyean also discloses determining whether a pointer associated with said game application is in a predetermined relationship with respect to an interactive element of said one or more interactive elements **(see Column 7, Lines 8-28 for the user having local simulation program that interacts with local storage to store local variables that is used to control the game application).**

Claim 18 corresponds to claim 16, where Galyean also discloses executing a predetermined action associated with said interactive element in response to said selection being associated with said interactive element **(see**

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**Column 7, Lines 29-62 for executing predetermined actions based on a state machine that responses to the viewers' inputs).**

Claim 19 corresponds to claim 1, where Ohba also discloses at least a portion of said game application is received over an interactive television network **(see Column 13, Line 66 through Column 14, Line 4 for transmitting the synchronization signals used by game machines A through C, wherein the synchronization signals represent a portion of the game application because the game application uses the synchronization signals to operate the combat game played by game machines A through C).**

Claim 20 corresponds to claim 1, where at least a portion of said game application is received over an interactive television network using an RF signal **(see the rejection of claim 19 and further note that television signals transmitted from a satellite are radio frequency signals).**

Claim 21 corresponds to claim 1, where Galyean and Ohba disclose all of the limitations of claim 1, but fail to teach that at least a portion of said game application is received over a video-on-demand system.

The examiner takes Official Notice that game application can be received over a VOD system.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, by modifying the television network, as taught

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by Galyean and Ohba, using a VOD system, as taught by the Examiner's Official Notice, for the purpose of only requesting and a receiving a game application when the viewer desires to play the game.

Claim 22 corresponds to claim 1, where at least a portion of said game application is received over a satellite system (**see the rejection of claim 19**).

Claim 23 corresponds to claim 1, where at least a portion of said game application is received over a cable system (**see the rejection of claim 21 and further note that it is well known to receive at least a portion of a game application over a cable system**).

Claim 24 corresponds to claim 1, where at least a portion of said game application is received over a broadcast system (**see the rejection of claim 19**).

Referring to claims 31-49, see the rejection of claims 6-24, respectively.

Referring to claims 56-74, see the rejection of claims 6-24, respectively.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P. Salce whose telephone number is (571) 272-7301. The examiner can normally be reached on M-F 9am-6pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason P Salce/  
Primary Examiner, Art Unit 2421

Jason P Salce  
Primary Examiner  
Art Unit 2421

November 19, 2008